

Katherine D. Prescott (SBN 215496)  
(katherine.prescott@wilmerhale.com)  
WILMER CUTLER PICKERING  
HALE AND DORR LLP  
950 Page Mill Road  
Palo Alto, CA 94304  
Telephone: (650) 858-6000  
Facsimile: (650) 858-6100

Joseph J. Mueller (*pro hac vice*)  
(joseph.mueller@wilmerhale.com)  
Sarah B. Petty (*pro hac vice*)  
(sarah.petty@wilmerhale.com)  
WILMER CUTLER PICKERING  
HALE AND DORR LLP  
60 State Street  
Boston, MA 02109  
Telephone: (617) 526-6000  
Facsimile: (617) 526-5000

*Attorneys for Defendant and  
Counterclaim-Plaintiff McAfee, Inc.*

**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION**

TVIIM, LLC,

Plaintiff,

v.

MCAFEE, INC.,

Defendant.

**Civil Action No. 3:13-cv-04545 (JST)**

**MCAFEE, INC.'S ANSWER,  
DEFENSES, AND COUNTERCLAIMS  
TO FIRST AMENDED COMPLAINT**

**DEMAND FOR JURY TRIAL**

Hon. Jon S. Tigar

1                   **MCAFEE, INC.'S ANSWER, DEFENSES, AND COUNTERCLAIMS TO**  
2                   **FIRST AMENDED COMPLAINT**

3                   Pursuant to Rules 8, 12, and 13 of the Federal Rules of Civil Procedure and the Local  
4 Rules of this Court, Defendant McAfee, Inc. ("McAfee") hereby responds to the allegations set  
5 forth in the First Amended Complaint of TVIIM, LLC ("TVIIM" or "Plaintiff") as follows:

6                   **JURISDICTION**<sup>1</sup>

7                   1.       McAfee admits that this is an action for patent infringement under the laws of the  
8 United States. McAfee also admits that this Court has subject matter jurisdiction over this action  
9 pursuant to 28 U.S.C. § 1338(a), but denies that McAfee has infringed or is infringing any claim  
10 of U.S. Patent No. 6,889,168 ("the '168 patent").

11                   **VENUE**

12                   2.       McAfee admits that venue is proper in this district pursuant to 28 U.S.C.  
13 §§ 1391(b) and (c) and 1400(b).

14                   3.       Paragraph 3 contains no allegation to which a response is required. To the extent  
15 that any response is required, McAfee admits that it transacts business in this judicial district, but  
16 denies that it has committed any act of infringement of the '168 patent.

17                   **PARTIES**

18                   4.       McAfee lacks knowledge or information sufficient to form a belief as to the truth  
19 of the allegations in paragraph 4 and, therefore, denies them.

20                   5.       Admitted.

21                   **THE PATENT AT ISSUE**

22                   6.       McAfee admits that an uncertified copy of the '168 patent is attached to the  
23 Complaint as Exhibit A and is entitled "Method and Apparatus for Assessing the Security of a  
24 Computer System." McAfee admits that two certificates of correction are also attached as  
25  
26

---

27 <sup>1</sup> For convenience and clarity, McAfee's Answer uses the same headings as in TVIIM's  
28 First Amended Complaint. McAfee does not admit any of the allegations contained in TVIIM's  
headings.

1 Exhibit A. McAfee lacks knowledge or belief regarding whether Innerwall owns and has  
2 standing to sue for infringement of the '168 patent, and therefore denies that allegation.

3 7. McAfee admits that the '168 patent issued on May 3, 2005. As to the other  
4 allegations in this paragraph, McAfee avers that the patent speaks for itself.

5 8. McAfee lacks knowledge or information sufficient to form a belief as to the truth  
6 of the allegation in paragraph 8 and, therefore, denies it.

7 **CLAIM FOR PATENT INFRINGEMENT**

8 9. McAfee reasserts and incorporates by reference its responses to paragraphs 1  
9 through 8 of the Answer as if fully set forth herein.

10 10. McAfee lacks knowledge or information sufficient to form a belief as to the truth  
11 of the allegation in paragraph 10 and, therefore, denies it.

12 11. Denied.

13 12. Denied.

14 13. Denied.

15 **PRAYER FOR RELIEF**

16 McAfee denies that TVIIM is entitled to any relief.

**MCAFEE, INC.'S DEFENSES**

**FIRST AFFIRMATIVE DEFENSE**

**(Non-Infringement)**

1. McAfee has not infringed and is not infringing, either directly, contributorily, or by inducement, any valid or enforceable claim of U.S. Patent No. 6,889,168 (“the ’168 patent”), either literally or under the doctrine of equivalents.

**SECOND AFFIRMATIVE DEFENSE**

**(Invalidity)**

2. One or more of the claims of the ’168 patent are invalid for failing to meet one or more of the statutory requirements and/or conditions for patentability under 35 U.S.C. §§ 101, 102, 103, and/or 112.

**THIRD AFFIRMATIVE DEFENSE**

**(No Injunctive Relief)**

3. Plaintiff is not entitled to injunctive relief because any alleged injury to Plaintiff is neither immediate nor irreparable, and Plaintiff has an adequate remedy at law.

**FOURTH AFFIRMATIVE DEFENSE**

**(Government Sales)**

4. To the extent that any accused product has been used or manufactured by or for the United States Government, Plaintiff’s purported claims for damages are limited by 28 U.S.C. § 1498.

**RESERVATION OF ADDITIONAL DEFENSES**

5. McAfee reserves any and all additional defenses available under Section 35 of the United States Code, the rules, regulations, or laws related thereto, the Federal Rules of Civil Procedure, the Rules of this Court, and/or otherwise in law or equity, now existing, or later arising, as may be discovered.

**MCAFEE, INC.'S COUNTERCLAIMS**

Counterclaim-Plaintiff McAfee, Inc. ("McAfee"), on personal knowledge as to its own acts, and on information and belief as to all others based on its own and its attorneys' own investigation, alleges Counterclaims against Counterclaim-Defendant TVIIM, LLC ("TVIIM") as follows:

**NATURE OF THE ACTION**

1. On information and belief, according to the allegations set forth in the First Amended Complaint, TVIIM is the owner of the entire right, title, and interest in and to U.S. Patent No. 6,889,168 ("the '168 patent").

2. TVIIM has accused McAfee of infringing the '168 patent. McAfee denies that any of its products infringe any valid or enforceable claim of the '168 patent.

3. An actual case and controversy exists between the parties concerning the infringement of one or more claims of the '168 patent, and that controversy is ripe for adjudication by this Court.

**PARTIES**

4. Counterclaim-Plaintiff McAfee is a Delaware corporation with its principal place of business in Santa Clara, California.

5. On information and belief, according to the allegations in paragraph 4 of the First Amended Complaint, Counterclaim-Defendant TVIIM is a Colorado limited liability company with a principal place of business in Boulder, Colorado.

**JURISDICTION AND VENUE**

6. These are Counterclaims for a declaration of non-infringement and invalidity of one or more claims of the '168 patent. This Court has subject matter jurisdiction over these Counterclaims pursuant to 28 U.S.C. §§ 1331, 1338, 2201, and 2202.

7. This Court has personal jurisdiction over TVIIM because TVIIM has already submitted to the jurisdiction of this Court by initiating the instant lawsuit.

8. Venue for these Counterclaims is legally proper in this District pursuant to 28 U.S.C. §§ 1367 and 1391 and because TVIIM chose to bring its action in this forum.

**FIRST COUNTERCLAIM**

**(Declaration of Non-Infringement of the '168 Patent)**

9. McAfee repeats and realleges the allegations of the preceding Answer Paragraphs 1-13, Defenses Paragraphs 1-5, and Counterclaims Paragraphs 1-8 as if fully set forth herein.

10. McAfee has not infringed and is not infringing, either directly, contributorily, or by inducement, any valid or enforceable claim of the '168 patent, either literally or under the doctrine of equivalents.

11. To resolve the legal and factual questions raised by TVIIM and to afford relief from the uncertainty and controversy that TVIIM's accusations have precipitated, McAfee is entitled to declaratory judgment that it has not infringed and is not infringing, directly or indirectly, any valid or enforceable claim of the '168 patent, either literally or under the doctrine of equivalents.

**SECOND COUNTERCLAIM**

**(Declaration of Invalidity of the '168 Patent)**

12. McAfee repeats and realleges the allegations of the preceding Answer Paragraphs 1-13, Defenses Paragraphs 1-5, and Counterclaims Paragraphs 1-11 as if fully set forth herein.

13. One or more claims of the '168 patent are invalid for failing to meet one or more of the requisite statutory and decisional requirements and/or conditions for patentability under one or more of 35 U.S.C. §§ 101, 102, 103, and/or 112.

1           14. To resolve the legal and factual questions raised by TVIIM and to afford relief  
2 from the uncertainty and controversy from which TVIIM's accusations have precipitated,  
3 McAfee is entitled to a declaratory judgment that the '168 patent is invalid.

4                                   **PRAYER FOR RELIEF**

5           WHEREAS, MCAFEE requests that this Court enter a judgment in its favor and against  
6 TVIIM as follows:

- 7           (a) Dismiss the Complaint in its entirety, with prejudice;  
8           (b) Enter judgment in favor of McAfee and against TVIIM;  
9           (c) Declare that the '168 patent has not been infringed by McAfee;  
10          (d) Declare that the '168 patent is invalid;  
11          (e) Declare that this is an exceptional case under 35 U.S.C. § 285 and award McAfee  
12 its costs (including expert fees), disbursements, and reasonable attorneys' fees incurred in this  
13 action; and  
14          (f) Grant such further relief as the Court deems just and proper.

15                                   **DEMAND FOR JURY TRIAL**

16 In accordance with Fed. R. Civ. P. 38(b), McAfee hereby demands trial by jury on all issues so  
17 triable.  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 Dated: December 5, 2013

Respectfully submitted,

3 /s/ Katherine D. Prescott

4 Katherine D. Prescott (SBN 215496)  
5 (katherine.prescott@wilmerhale.com)  
6 WILMER CUTLER PICKERING  
7 HALE AND DORR LLP  
8 950 Page Mill Road  
9 Palo Alto, CA 94304  
10 Telephone: (650) 858-6000  
11 Facsimile: (650) 858-6100

12 Joseph J. Mueller (pro hac vice pending)  
13 (joseph.mueller@wilmerhale.com)  
14 Sarah B. Petty (pro hac vice pending)  
15 (sarah.petty@wilmerhale.com)  
16 WILMER CUTLER PICKERING  
17 HALE AND DORR LLP  
18 60 State Street  
19 Boston, MA 02109  
20 Telephone: (617) 526-6000  
21 Facsimile: (617) 526-5000

22 *Attorneys for Defendant and*  
23 *Counterclaim-Plaintiff McAfee, Inc.*  
24  
25  
26  
27  
28



**CERTIFICATE OF SERVICE**

I hereby certify under penalty of perjury under the laws of the United States that a true and correct copy of the above and foregoing document has been served on December 5, 2013 to all counsel of record who are deemed to have consented to electronic service via the Court's ECF system per Civil Local Rule 5-1.

Dated: December 5, 2013

/s/ Katherine D. Prescott

Katherine D. Prescott